

Protestors' File: 73310.72608

REISSUE LITIGATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:

**BILL L. DAVIS and JESSE S. WILLIAMSON**

For Reissue of U.S. Patent 5,630,363

Issued May 20, 1997

Serial No. 08/515,097

Filing Date: May 20, 1999

Serial No.: 09/315,796

For: **COMBINED LITHOGRAPHIC/  
FLEXOGRAPHIC PRINTING  
APPARATUS AND PROCESS**

TO: The Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Dear Sir:

**PROTEST UNDER 37 C.F.R. §1.291 TO REQUEST  
SUSPENSION OF REISSUE PROCEEDINGS**

This protest is filed by the undersigned on behalf of Printing Research, Inc. and Howard W. DeMoore, Plaintiffs in Civil Action No. 3-99 CV 1154-D, now pending in the United States District Court for the Northern District of Texas, Dallas Division ("the concurrent litigation").

This protest is filed for the sole purpose of requesting that the PTO suspend this reissue proceeding pending judicial determination of the inventorship/ownership issues that are pending in the concurrent litigation. Any consideration of other issues relating to prior art, claim language and patentability is premature and potentially prejudicial to Protestors until the inventorship/ownership issues are resolved.

Protestors assert in the concurrent litigation that Bill L. Davis and Jesse S. Williamson are not the proper inventors of all claims pending in U.S. 5,630,363, and that Williamson

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Printing Corporation is therefore not the rightful patent owner. In an Order (copy attached) dated September 1, 1999, the Court lifted a stay in the concurrent litigation following comprehensive briefing by Protestors and Reissue Applicants on the subject of whether Protestors will be irreparably harmed if the inventorship issues are not determined prior to resolution of the reissue proceeding in the PTO. The Court concluded that potential prejudice to Protestors outweighed any potential benefit to the court from prior PTO action on the reissue. The Court further ordered Protestors and Reissue Applicants to submit a joint scheduling proposal not later than September 30, 1999.

MPEP §1442.02 states that action in reissue applications is suspended automatically where there is concurrent litigation unless one of the four listed exceptions applies. In this case, however, Protestors' submit that the reissue proceedings should be suspended even if Reissue Applicants request that they be continued simultaneously with the litigation. Unless Reissue Applicants are the rightful legal owners of the '363 patent, there is no statutory basis for permitting them to prosecute the reissue application. Because a principal issue in the litigation is ownership of the '363 patent and because Reissue Applicants want to defeat Protestors' ownership claims, Reissue Applicants have an obvious strategic reason for hurrying the reissue while giving lip service to the court that the inventorship/ownership aspects of the pending controversy are being addressed in the PTO.

Reissue Applicants' submissions to the PTO regarding inventorship are not publicly available (Reissue Applicants having moved to expunge) and Reissue Applicants have not even provided copies of those submissions to Protestors. Only in the concurrent litigation will Protestors have opportunity under the Federal Rules of Civil Procedure to compel disclosure of Reissue Applicants' proofs regarding inventorship, take discovery and cross-examine Reissue Applicants' inventorship claims. Protestors' patent rights will be prejudiced and possibly destroyed by actions taken and decisions made by Reissue Applicants during the reissue proceedings. Permitting Reissue Applicants to add, amend and cancel claims selectively, without Protestors' knowledge and participation, is likely to produce a patent having different claim content and scope than if Protestors prevail in their inventorship claims made in the concurrent litigation.

Only by suspending the reissue proceedings can the rights of both Protestors and Reissue Applicants be preserved. If Protestors fail to establish their contentions regarding inventorship

and conversion as presented in the concurrent litigation, Reissue Applicants will have lost no right or opportunity with regard to shaping the claims of the reissue application.

For the foregoing reasons, Protestors respectfully urge that the instant reissue proceedings be suspended pending a determination of the inventorship/ownership issues in the concurrent litigation. The PTO has discretion to suspend the reissue proceedings pending a judicial determination of the inventorship/ownership issues, and fairness to the parties requires suspending the reissue proceedings under these circumstances. The public interest is not well served and PTO resources are not well utilized if the wrong inventors are permitted to further prosecute the claims of U.S. 5,630,363 in this proceeding.

Respectfully submitted,

By: 

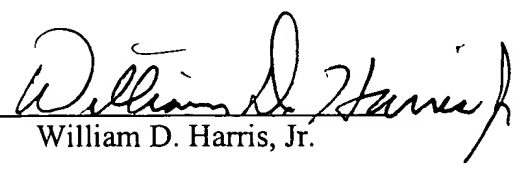
William D. Harris, Jr.  
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Date: September 14, 1999

LOCKE LIDDELL & SAPP LLP  
2200 Ross Avenue, Ste. 2200  
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#### CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PROTEST UNDER C.F.R. §1.291 TO REQUEST SUSPENSION OF REISSUE PROCEEDINGS** was served on Reissue Applicants' counsel of record, Robert Hardy Falk, FALK & FISH, LLP, 700 North Pearl Street, Suite 970, LB 366, Dallas, Texas 75201, by U.S. mail, first class postage prepaid, this 14th day of September, 1999.

  
William D. Harris, Jr.

cc: John Pinkerton, Esq.

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